

Appl. No. 10/619,736
Atty. Docket No. CM2503RQ
Amdt. dated March 21, 2007
Reply to Office Action mailed 12/27/2006
Customer No. 27752

REMARKS

Formal Matters

Claim 12 has been amended in order to present the claim in proper dependent form. As now presented, Claim 12 further limits the method of Claim 8. No new matter is presented in the instant Application by virtue of the current amendment. Claims 1-12 remain pending in the instant Application and are presented for the Examiner's review in light of the above amendment and the following comments.

Claim Objection

Claim 12 was objected to under 37 C.F.R. §1.75(c). By amendment herein, Applicants have amended the preamble of dependent Claim 12 to recite a further limitation of the method of Claim 8. Applicants respectfully request removal of the Examiner's objection to Claim 12.

Rejection Under 35 U.S.C. §102

Claims 10-11 have been rejected under 35 U.S.C. §102(b) or, in the alternative, under 35 U.S.C. §103(a) over Wells, U.S. Patent No. 3,414,459. Previously arguments made with regard to the rejection of Claims 10 and 11 with respect to the *Wells* reference remain in effect but will not be repeated for the sake of brevity. The Examiner is respectfully requested to reconsider the instant rejection in light of the following additional comments.

Claim 10 of the instant Application claims a tissue paper product made according to the method of instant Claim 1. In short, the subject matter of instant Claim 1 is directed toward a method of making a tissue paper product from a tissue paper web. The method comprises the steps of, *inter alia*, passing the tissue paper web through an embossing nip and then through a calendering nip. The embossing nip is formed between a first and second embossing roll wherein one of the embossing rolls comprises at least thirty embossing elements per square centimeter each having a height of less than about 0.5 mm. The calendering nip exerts a pressure onto the paper web of at least about 120 N/cm.

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Applicants are at a loss to understand how Claims 10 and 11 of the instant Application can be rejected under 35 U.S.C. §102(b) over the *Wells* reference. The Examiner has kindly converted the calendar nip pressures disclosed by the *Wells* reference as ranging from 0.876 N/cm to 105.1 N/cm (0.5 to 60 lbs. per linear inch). Applicants' Claim 1 clearly requires the calendar nip pressure exerted onto the paper web to be at least about 120 N/cm.

It goes without saying that it is long standing Federal Circuit law that, "Anticipation based on a printed publication under §102(a) requires the presence in the publication of each and every limitation of the claimed invention." See *Novo Nordisk Pharmaceuticals, Inc. v. Bio-Technology General Corp.*, 424 F.3d 1347 (Fed. Cir. 2005). The *Wells* reference does not disclose the exertion of at least about 120 N/cm of said contact length, as required by Applicants' Claim 1. Absent such disclosure, the *Wells* reference cannot anticipate Applicants' Claim 10.

With regard to the Examiner's rejection of Claims 10 and 11 under 35 U.S.C. §103(a) over the *Wells* reference, Applicants respectfully draw the Examiner's attention to the specification, as originally filed. Applicants state, "... in accordance with the present invention unusually high calendering pressures are used." (9:3) The use of such unusually high calendering pressures lead to a surprising result. "It has been surprisingly found that the embossing step in combination with the calendering step leads to a rather thick and bulky and yet still very soft paper product. More particularly, it has been found that the paper tissue web after undergoing a stretch embossing step and a calendering step is of **increased caliper** as compared to the untreated web.... This effect is particularly surprising [since] a calendering with a high pressure is known to [typically] reduce the caliper of a paper web considerably." (9:26-33; emphasis added)

"An applicant may make [a] showing [of surprising results] with evidence that the claimed invention exhibits some superior property or advantage that a person of ordinary skill in the relevant art would find surprising or unexpected.... The basic principle behind this rule is straightforward – that which would have been surprising to a person of ordinary skill in a particular art would not have been obvious." See *In re Mayne*, 104 F.3d 1339, 41 U.S.P.Q.2d 1451 (Fed. Cir. 1997). Thus, "... when the measured property

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serves to point up the distinction from the prior art, or advantages over the prior art, that property is relevant to patentability, and its numerical parameters cannot only add precision to the claims but also may be considered, along with all of the evidence, in determination of patentability.” See *In re Glaug*, 283 F.3d 1335, 62 U.S.P.Q.2d 1151 (Fed. Cir. 2002) (citing *Pall Corp. v. Micron Separations, Inc.*, 66 F.3d 1211, 1216, 36 U.S.P.Q.2d 1225, 1228 (Fed. Cir. 1995). See also, *In re Soni*, 54 F.3d 746, 750 (34 U.S.P.Q.2d 1684, 1687 (Fed. Cir. 1995) (“One way for a patent applicant to rebut a *prima facie* case of obviousness is to make a showing of ‘unexpected results, i.e., to show that the claimed invention exhibits some superior property or advantage that a person of ordinary skill in the relevant art would have found surprising or unexpected.”)

When those of skill in the art would understand that traditional calendering with high pressures reduces the caliper of the resulting paper web considerably, the finding that the embossing step of the instant Application in combination with the calendering step leads to a rather thick and bulky and yet still very soft paper product is indeed a surprising result. Therefore, Applicants’ claimed invention is indeed unobvious over the references cited by the Examiner.

Thus, Applicants respectfully request withdrawal of the Examiner’s 35 U.S.C. §102(b) and 35 U.S.C. §103(a) rejection to Claim 10 over the *Wells* reference, as well as all claims dependent thereon.

Rejections Under 35 U.S.C. §103

Claims 1-3, 5-9, and 12 have been rejected under 35 U.S.C. §103(a) over *Wells*, with or without *Kamps, et al.*, U.S. Patent No. 5,702,571 or *Brown, et al.*, U.S. Patent No. 5,693,403. Previous arguments made with regard to the *Wells*, *Kamps*, and *Brown* references remain in effect but will not be repeated for the sake of brevity. The Examiner is respectfully requested to reconsider the instant rejection in light of the following additional arguments.

As stated *supra*, Applicants’ independent Claim 1 requires, *inter alia*, the claimed process to include a calendering step wherein the calendering roll exerts a pressure onto the subject paper web of at least about 120 N/cm of contact length. As discussed *supra*,

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Applicants' claimed calendering step provides for a particularly surprising result in that the resulting product is a rather thick and bulky and yet still very soft paper product having an **increased** caliper as compared to an untreated web. The *Kamps* and *Brown* references cited by the Examiner do nothing to provide any teaching, disclosure, or suggestion to lead one of skill in the art to understand or have the motivation to use a high calendering pressure in a converting process to provide a very soft thick and bulky paper product. Absent such teaching, disclosure, or suggestion, the *Wells*, *Kamps* or *Brown* references, alone or in combination, cannot teach, disclose, or even remotely suggest Applicants' claimed method. Therefore, Applicants respectfully request withdrawal of the Examiner's 35 U.S.C. §103(a) rejection to Claim 1 over the *Wells*, *Kamps* and *Brown* references, as well as all claims dependent thereon.

Claims 1-3 and 5-12 have been rejected under 35 U.S.C. §103(a) over Jennings, et al., International Publication No. WO 98/58124 in view of Roussel, et al., International Publication No. WO 99/45205 or *Kamps*. Previous arguments made with regard to the *Jennings*, *Roussel*, and *Kamps* references remain in effect but will not be repeated for the sake of brevity. The Examiner is respectfully requested to consider the following additional arguments that clearly distinguish Applicants' claimed invention in view of the cited prior art.

As discussed *supra*, Applicants found it surprising that the claimed embossing step in combination with the calendering step leads to a thick and bulky and yet still very soft paper product. (9:26-27) Applicants found the effect to be particularly surprising since it is believed that those of skill in the art understand that calendering with a high pressure is known to reduce the caliper of a paper web considerably. (9:31-33) However, Applicants respectfully believe that the *Jennings* reference in fact teaches away from the use of calendering as used by Applicants in the present invention.

The Federal Circuit has noted that, "We have noted ..., as a 'useful general rule,' that references that teach away cannot serve to create a *prima facie* case of obviousness." *See McGinley v. Franklin Sports, Inc.*, 262 F.3d 1339, 60 U.S.P.Q.2d 1001 (Fed. Cir. 2001) (citing *In re Gurley*, 27 F.3d 551, 553, 31 U.S.P.Q.2d 1130 (Fed. Cir. 1994)). "[I]n general, a reference will teach away if it suggests that the line of development flowing

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from the reference's disclosure is unlikely to be productive of the result sought by the applicant." *See Backster International, Inc. v. McGaw, Inc.*, 149 F.3d 1321, 47 U.S.P.Q.2d 1225 (Fed. Cir. 1998) (citing *In re Gurley*).

Applicants believe the disclosure of the *Jennings* reference teaches away from Applicants' claimed invention inasmuch as the *Jennings* reference is directed toward a "method of optimizing the balance between sheet calipers for winding tension and embossing element height for pattern definition." (p. 2, ll. 14-16) The *Jennings* reference states that, "... calendering has traditionally been used to **reduce** sheet thickness and embossing has been used to increase sheet thickness...." (2:13-14; emphasis added) A goal of the *Jennings* reference is to provide for a sheet material having high bulk leaving an improved embossing pattern clarity. (2:5-7) The *Jennings* reference also recognizes that while embossing provides for increased pattern definition, the use of a calendering operation reduces the effect of such an embossing step. Thus, the *Jennings* reference does not seek to increase the caliper of a tissue paper web, as is claimed by Applicants' invention, but rather tries to find the appropriate balance between embossing height and roll bulk by managing the amount of calendering provided to the paper tissue. Thus, it is clear that the *Jennings* reference actually teaches away from the use of calendering to achieve high bulk and provide for a thick paper. Contrastingly, Applicants utilize the calendering operation to increase these characteristics of the resulting tissue product.

In light of the above discussion, Applicants respectfully believe that the disclosure of the *Jennings* reference effectively teaches away from Applicants' claimed invention. Therefore, Applicants respectfully request the rejection to Claims 1-3 and 5-12 under 35 U.S.C. §103(a) over *Jennings* in view of *Roussel* or *Kamps* be withdrawn.

Conclusion

Based on all the foregoing, it is respectfully submitted that each of Applicants' remaining claims is in condition for allowance and favorable reconsideration is requested.

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This response is timely filed pursuant to the provisions of 37 C.F.R. §1.8 and M.P.E.P. §512. If any additional charges are due, the Examiner is authorized to deduct such charges from Deposit Account No. 16-2480 in the name of The Procter & Gamble Company.

Respectfully submitted,

THE PROCTER & GAMBLE COMPANY

By 

Peter D. Meyer
Attorney for Applicant
Registration No. 47,792
(513) 634-7419

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